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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/583,308	04/13/2007	Koji Hamada	SCEY 22.540 (100809-00325)	5094
26304 7590 03/21/2011 KATTEN MUCHIN ROSENMAN LLP 575 MADISON AVENUE NEW YORK, NY 10022-2585				
EXAMINER				
MAMO, ELIAS				
ART UNIT		PAPER NUMBER		
2184				
MAIL DATE		DELIVERY MODE		
03/21/2011		PAPER		

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	10/583,308	HAMADA ET AL.
	<b>Examiner</b>	<b>Art Unit</b>
	ELIAS MAMO	2184

**-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --**  
**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) ☒ Responsive to communication(s) filed on 10 March 2010.
- 2a) ☐ This action is **FINAL**.                      2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) ☒ Claim(s) 1-3,5-7 and 9-13 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-3,5-7 and 9-13 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
 Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All    b) ☐ Some \*    c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
  2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

- |  |   |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)<br>2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)<br>3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>10/05/2010</u> | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date _____<br>5) <input type="checkbox"/> Notice of Informal Patent Application<br>6) <input type="checkbox"/> Other: _____ |
|--|---|

**DETAILED ACTION**

***Continued Examination Under 37 CFR 1.114***

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 03/10/2010 has been entered.

***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

**Claims 1-3, 5-7 and 9-13** are rejected under 35 U.S.C. 103(a) as being unpatentable over Hoshino et al. (US 6,761,635), hereinafter referred to as Hoshino in view of common knowledge in the art.

**Referring to claim 1**, Hoshino discloses, a relay unit incorporated in a gaming system (game console 1, Fig. 1) and connecting one or a plurality of manipulation terminals or external storage units (controller 20, Fig. 1) to a single port (PAD/Memory Card Reader 7A-8B, Fig. 7) of an entertainment apparatus (game console 1, Fig. 1) having at least a first mode and a second mode as operation modes (the console operates games from CDs and DVDs in addition to playing movies from optical disks, column 4, lines 8-14);

wherein the entertainment apparatus reads information from a recording medium, determines an operation mode based on the read information, generates an operation mode selection signal in accordance with the determined operation mode (IOP sends an operational mode identifier, Fig. 9), and outputs the generated operation mode selection signal to the relay unit (when the optical disk in is detected as being a DVD game, the system enters controller emulation mode, column 12, lines 20-25);

the relay unit includes: a first relay processing unit; a second relay processing unit (the game system is operable to run games from both CDROM format disks and DVDROM format disks, column 4, lines 8-12); and

a control signal generator (IOP 120, Fig. 7);

the first relay processing unit carries out relay processing for the first mode between the entertainment apparatus and the one or the plurality of manipulation terminals or the external storage units (when a DVD video game is inserted the device operates runs the game and takes input for the video game from the controller 20 and an the remote 40, column 12, lines 19-25);

the second relay processing unit carries out relay processing for the second mode between the entertainment apparatus and the one or the plurality of manipulation terminals or the external storage units (it is seen as inherent that when a CDROM video game is inserted into the console, the CDROM processing would be activated to receive input from the controller 20 and the remote 40, column 12, lines 19-25);

the control signal generator operates one of the first and second relay units to carry out the relay processing based on the received selection signal (The IOP reads out the Device IDs to the operate the device, column 11, lines 8-15); and

said the relay unit having a connector detachably connecting the entertainment apparatus and the relay unit and (controller 20, Fig.1) wherein said the first and second modes are different gaming protocols (CDROM video games and DVDROM video games, column 4, lines 8-15).

However, Hoshino does not explicitly teach the relay unit being located outside the entertainment apparatus and includes: a main body connector for detachably connecting the relay unit to the entertainment apparatus; at least one or a plurality of connectors for detachably connecting the one or more plurality of manipulation terminals.

On the other hand, it would have been obvious to a person of ordinary skill in the art to modify the teachings of Hoshino so that the relay unit is becomes separated and located outside the entertainment apparatus and includes: a main body connector for detachably connecting the relay unit to the entertainment apparatus; at least one or a plurality of connectors for detachably connecting the one or more plurality of manipulation terminals, since it has been held that constructing a formerly integral structure in various elements and make it separate to locate it outside involves only routine skill in the art. *Nerwin V. Erlichman*, 168 USPQ 177, 179. *In re. Japikse*, 86 USPQ 70. The motivation for doing so would have been to make scalable, easy for maintenance and convenience.

**As per claim 2**, the modified Hoshino discloses, in at least either the case of changing from the first mode to the second mode or changing from the second mode to the first mode, a

period in which neither relay processing for the first mode nor relay processing for the second mode is carried out for mode switching is provided (It is seen as inherent then when the drive tray of the console is empty, i.e. when one disk has been removed and another has yet to be inserted, the processing modules linked to the IOP would not be processing, Fig. 7).

**As per claim 3**, the modified Hoshino discloses, the duration of the period in which neither relay processing for the first mode nor relay processing for the second mode is carried out is defined according to a communication procedure with the entertainment apparatus (The IOP determines what processing occurs when it transmits the operational mode identifier, Fig. 9).

**As per claim 5**, the modified Hoshino discloses, the control signal generator is configured to generate a first control signal to operate the first relay processing unit and a second control signal to operate the second relay processing unit in conformity with the selection signal (The IOP determines what processing occurs when it transmits the operational mode identifier, Fig. 9).

**As per claim 6**, the modified Hoshino discloses, the control signal generator comprises a pulse generator configured to generate pulses of a predetermined width when changing from the first mode to the second mode, or from the second mode to the first mode (the microcomputer 34 generates pulse information for digital control signals, column 12, lines 52-58).

**As per claim 7**, the modified Hoshino discloses, the second mode is a compatible mode for insuring compatibility with other entertainment apparatuses of other models (this is seen as inherent as CDROM type games are a legacy format as compared to DVD ROM type games, column 4, lines 8-12).

**Referring to claim 9**, corresponding limitations as found in claim 1 are recited. Therefore the rejection of claim 1 applies to claim 9.

**Referring to claim 10**, corresponding limitations as found in claim 1 are recited. Therefore the rejection of claim 1 applies to claim 10.

**As per claim 12 as dependent upon each of claims 10 and 11**, corresponding limitations as found in claim 2 are recited.



Therefore the rejection of claim 2 applies to claim 12.

**As per claim 13**, corresponding limitations as in claim 3 are recited. Therefore the rejection of claim 3 applies to claim 13.

**Referring to claim 14**, corresponding limitations as found in claim 8 are recited. Therefore the rejection of claim 8 applies to claim 14.

**As per claim 11**, it is noted that Hoshino does not appear to explicitly disclose, the step of determining includes setting operation mode to the first mode when the recording medium is removed, and generating a selection signal corresponding to the first mode.

However, one of ordinary skill in the art would recognize that as DVD video games are the more modern format and the so called normal operation mode of the instant invention, it would be obvious to default the selection of DVD processing. Further, when the system is powered on, there would generally be a

default state when which would generally be the primary media format, DVD, as opposed to the legacy format, CD.

The motivation for doing so would have been that by maintaining a default state that selects the DVD processing state, the system would save switching time. A default state choosing the DVD as the default would be obvious to a designer since it is the modern format and therefore the expected input into the system. The CD support is the legacy format.

Examiner's note:

*Examiner has cited particular columns and line numbers in the references applied to the claims above for the convenience of the Applicant. Although the specified citations are representative of the teachings of the art and are applied to specific limitations within the individual claim, other passages and figures may apply as well. It is respectfully requested from the Applicant in preparing responses, to fully consider the references in entirety as potentially teaching all or part of the claimed invention, as well as the context of the passages as taught by the prior art or disclosed by the Examiner.*

***Response to Arguments***

Applicant's arguments filed on 03/10/2010 have been fully considered but they are moot in view of the new grounds of rejection.

***Contact Information***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to ELIAS MAMO whose telephone number is (571) 270-1726 and fax number (571) 270-2726. The examiner can normally be reached on Monday thru Thursday from 9 AM to 5 PM EST. The examiner can also be reached on alternate Fridays.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Dr. Henry Tsai, can be reached on (571) 272-4176. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through

Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

/ELIAS MAMO/

Examiner, Art Unit 2184